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EXAMINER				
CHAWLA, JYOTI				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/784,980

**Applicant(s)**

BELL ET AL.

**Examiner**

JYOTI CHAWLA

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 4, 6-28, 30, 31, 33-36 and 46-57 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-9, 28, 30, 31, 33-36 and 55-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-913)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Applicant's submission filed on 11/20/2009 has been entered. Claims 1, 3, 4, 6-28, 30, 31, 33-36 and 46-57 are pending in the application. Claims 10-27 and 46-54 have been withdrawn from further consideration as being directed to a non-elected invention. Claims 1, 3, 4, 6-9, 28, 31, 33-34 and 55 have been amended and 56-57 have been added in the current amendment. Claims 1, 3-4, 6-9, 28, 30-31, 33-36 and 55-57 are examined in the present office action.

### ***Claim Rejections - 35 USC § 112***

Rejection of claims 1, 28 and 55 recite the limitation "unpleasant mouth feel", for being indeterminate as it is a subjective description that may vary from one person to another, thus rendering the claims indefinite, has been withdrawn based on applicants' amendments to claims 1, 28 and 55 specifying the botanicals and clarifying the unpleasant mouthfeel is because of the botanical.

However, independent claims now recite that unpleasant mouthfeel is associated with botanicals "Echinacea, Siberian ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. John's wort, Valerian and Ephedra and combinations thereof", i.e., if any or a combination of above listed botanicals are present in a confection or food product, said botanicals will contribute an unpleasant mouthfeel to the confection or food product. Therefore, for the purposes of expediting the prosecution any confection with a botanical and having the claimed range of partially hydrogenated vegetable oils or saturated fats would be considered relevant prior art.

Rejection of claims 4, 31 for the recitation of "partially hydrogenated vegetable oil may be selected from the group consisting of cottonseed, soybean, peanut, palm, sunflower seed and corn oil and combinations thereof, and the saturated fat is selected

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from the group consisting of palm kernel oil, coconut oil cocoa butter, and butter, and combinations thereof" has been withdrawn based on applicants amendments dated 11/20/2009.

Rejection of claim 6, 7, 33 and 34 has also been withdrawn based on applicants amendments dated 11/20/2009, providing the units of measurement for the above mentioned claims.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejection of claims 1, 4-9, 28, 31-36 and 55 under 35 U.S.C. 102(b) as anticipated Carpenter et al (US 5637344) made in the previous office action dated 3/25/09 have been withdrawn based on applicants' amendments dated 11/20/09.

Rejection of claims 1, 4-9, 28, 31-36 and 55 under 35 U.S.C. 103(a) as unpatentable over Carpenter (US 5637344), in view of Seang (WO 94/05260) made in the previous office action dated 3/25/09 have been withdrawn based on applicants' amendments dated 11/20/09.

Rejection of claims 2-3 and 29-30 under 35 U.S.C. 103(a) as unpatentable over Carpenter (US 5637344), in view of Raymont (AU-A-71904/96) made in the previous office action dated 3/25/09 have been withdrawn based on applicants' amendments dated 11/20/09.

Rejection of claims 2-3 and 29-30 under 35 U.S.C. 103(a) as unpatentable over Carpenter (US 5637344), in view of Seang (WO 94/05260), further in view of Raymont (AU-A-71904/96) made in the previous office action dated 3/25/09 have been withdrawn based on applicants' amendments dated 11/20/09.

**1) Claims 1, 3-4, 6-9, 28, 30-31, 33-36 and 55-57 are rejected under 35 U.S.C. 103(a) as unpatentable over Carpenter (US 5637344), in view of the combination of Raymont (AU-A-71904/96) and Seang (WO 94/05260).**

Regarding claims 1, 3, 28, 30, 55 Carpenter teaches a hard boiled candy composition comprising (or consists essentially of):

Regarding step (a), Carpenter teaches a confectionery base comprised of a mixture of at least one sugar (Carpenter, column 6, lines 20-28) and at least one carbohydrate bulking agent (Carpenter, column 6, lines 33-35) which is kept in an amorphous or glassy condition (Carpenter, column 2, lines 55-61).

Regarding step (b) Carpenter discloses at least one botanical (e.g., cocoa powder, see Column 2, lines 65-67) having an unpleasant mouthfeel; however, Carpenter is silent as to the botanical being one from the list provided in amended claim 1, 28 and 55, i.e., botanical is selected from the group consisting of "Echinacea, Siberian Ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. Johns Wort, Valerian and Ephedra, and combinations thereof". Regarding claims 1, 3, 28, 30, 55, Raymont teaches a lozenge composition (page 3, lines 30-31), which are similar to hard candy compositions, which comprises at least one botanical, wherein the botanical may be Echinacea. Thus confections including hard confections with botanicals, such as, Echinacea, were known in the art at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carpenter such that the botanical may be Echinacea. One of ordinary skill would have been motivated to modify Carpenter at least for the purpose of deriving known benefits of Echinacea such as stimulation of immune system (see Raymont, page 5, lines 20-25).

Regarding step (c) Carpenter teaches an amount of from about 0.5% to about 5.0% by weight (Carpenter, column 9, lines 1-6) of said composition of an unpleasant mouthfeel suppressing agent consisting essentially of one or more partially hydrogenated vegetable oils or saturated fats where saturated fat may be cocoa butter or butter as recited in claims 1, 28, 55-57 (Carpenter, column 6, lines 58-67 and Column 7, lines 1-7), said amount being effective to suppress said unpleasant mouthfeel of said botanical.

It is noted that the recitation wherein the agent is "an unpleasant mouthfeel suppressing agent" and said amount "being effective to suppress said unpleasant mouthfeel" of said botanical are a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case given that the amount of hydrogenated vegetable oils or saturated fats taught by Carpenter falls in the recited range (Column 6, lines 58-67 and Column 7, lines 1-7), it follows that the prior art (i.e., Carpenter as described above) structure is capable of performing the intended use.

Further, Regarding the limitation of utilizing partially hydrogenated vegetable oils or saturated fats as unpleasant mouthfeel suppressing agent, Seang teaches that lipids (oils and fats) were known for masking the bitter taste (i.e., unpleasant mouthfeel) (Seang, Page 1, line 28, Page 4, lines 6-15, 35-37; Page 5, lines 5-7; Page 6, lines 5-15). Thus, effect of lipids in masking the unpleasant mouthfeel was known at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention that the partially hydrogenated vegetable oils or saturated fats in applicants' recited range, as taught by Carpenter will suppress the unpleasant mouthfeel of botanical in a similar manner as the partially hydrogenated vegetable oils or saturated fats in the instantly claimed invention.

Regarding type of fats, Carpenter teaches that the saturated fat may be cocoa butter or butter (Column 6, line 67 to Column 7, line 2) as recited in claims 1, 28, 56-58. However

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the reference is silent about the fat being selected from cottonseed, soybean, peanut, palm, sunflower or corn oil as recited in claims 4 and 31. However Seang teaches of partially hydrogenated vegetable oils including cottonseed oil (Page 6, lines 1-15). Thus, addition of partially hydrogenated and saturated fats to mask the flavor or suppress the mouthfeel of botanicals was known in the art at the time of the invention and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carpenter and utilize a partially hydrogenated vegetable oil, such as cottonseed oil in place of cocoa butter and butter (i.e., saturated fats) in applicants' recited range, as taught by Seang. One of ordinary skill would have been motivated to do so at least for the purpose of substituting one type of saturated fat for another type of saturated fat in the instantly claimed invention.

Regarding claims 6, 7, 33 and 34, Carpenter teaches that the saturated fat or partially hydrogenated vegetable oil may be present at greater than about 3% and less than 5% (Column 9, lines 1-6), which falls in the recited ranges of 0.5% to 3.5% (for claims 6 and 33) or 0.75% to 3.0% (for claim 7 and 34).

Regarding claims 8, 9, 35 and 36, Carpenter teaches that the ratio of the saturated fat or partially hydrogenated vegetable oil to the botanical is from about 1:100 to 3:1 (Col. 7, lines 40-45), which includes ratio values that falls in the recited range of ratios of 1/1 to about 1/0.1 (for claims 8 and 35) and from 1.0/0.6 to 1.0/0.15 (for claims 9 and 36).

### ***Response to Arguments***

Applicant's arguments submitted 11/20/09 regarding the rejection have been fully considered but are moot in view of new grounds of rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case Carpenter, Raymont and Seang are applied in a combination in an

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obviousness rejection and the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus applicants' arguments against the references individually are not persuasive.

Applicants' argue that Carpenter's cocoa powder causes unpleasant mouthfeel because of the rough surface of the particles (para 2, page 20). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unpleasant mouthfeel of cocoa powder in because of its rough surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case the claim recites "Echinacea, Siberian ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. John's wort, Valerian and Ephedra and combinations thereof, each having unpleasant mouthfeel" (claims 1, 28 and 55), where the nature of the unpleasantness has not been specifically claimed and thus unpleasant mouthfeel will be given broadest reasonable interpretation (see MPEP 2106 II c).

Similarly applicants' argument that "no one has taught or suggested the use of partially hydrogenated vegetable oils or saturated fats as the sole agent for suppressing unpleasant mouthfeel of the claimed botanicals" (Page 22, Paragraph 2, lines 4-6), which are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' argue that "no one has taught or suggested the use of partially hydrogenated vegetable oils or saturated fats as the sole agent for suppressing



unpleasant mouthfeel of the claimed botanicals", applicants' seem to have arrived at this conclusion because claims 1, 28 and 55 recite "unpleasant mouthfeel suppressing agent consisting essentially of one or more partially hydrogenated vegetable oils or saturated fats". However, applicant is referred to MPEP 2111.03 where it is clearly stated that for the purpose of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising."

Thus, applicants' arguments dated 11/20/2009 are not persuasive and claims 1, 3-4, 6-9, 28, 30-31, 33-36 and 55-57 are rejected for reasons of record.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/  
Examiner  
Art Unit 1794

/Keith D. Hendricks/  
Supervisory Patent Examiner, Art Unit 1794